

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

HORVAIS ET AL.

Atty. Ref.: 960-49; Confirmation No. 1461

Appl. No. 10/583,948

TC/A.U. 1637

Filed: October 20, 2006

Examiner: Bertagna

For: SOLID SUPPORT FOR NUCLEIC ACID DETECTION

* * * * *

November 12, 2008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE

Responsive to the Official Action dated June 12, 2008, the applicant elect, with traverse, the subject matter of the Examiner's Group II (i.e., claims 30-39, 46 and 47, drawn to a solid support and kits comprising the solid support).

Rejoinder and allowance of any claim defining a method of making and/or using a product defined by an allowable claim, at an appropriate time, are requested.

Reconsideration and withdrawal of the election requirement and lack of unity assertion are requested in view of the following comments.

The Examiner's assertion of lack of unity is based on the Examiner's belief that Van Beuningen (WO 2003/054551) allegedly "teaches all the limitations of claim 1." See page 2 of the Office Action dated June 12, 2008. The Examiner asserts that the

cited art allegedly discloses a method for determining the presence or absence of a target nucleic acid relative to a control nucleic acid:

wherein said method would comprise processing and detecting the target nucleic acid and the control under comparable conditions and determining the presence or absence of the target nucleic acid based on a comparison of the results obtained from the target and the control, page 3, line 25 – page 4, line 10 of Van Beuningen being therefor quoted in said Office Action; and

wherein the control nucleic acid would be adsorbed on a solid support, page 3, line 25 – page 4, line 10 and page 15, lines 48-23 of Van Beuningen being therefor quoted in said Office Action.

However, the applicants submit that claim 1 of the present application explicitly recites that, in the claimed method, the control nucleic acid *“is provided by a solid support onto which it is adsorbed, and from which a definite amount thereof is to be desorbed, whereby there is provided an essentially quantitatively reproducible and controlled amount of said control nucleic acid for submission to said comparable processing conditions.”* [emphasis added].

The Examiner has not indicated where the cited art teaches or describes the desorption features of claim 1 of the present application.

Because the Office Action dated June 12, 2008 has not taken into account all the features of claim 1, it is respectfully submitted that the lack of unity of invention determination is unsupported and should be withdrawn.

Furthermore, the applicants believe that Van Beuningen neither discloses nor teaches the desorption of the control nucleic acid from the solid support. The applicants further believe the cited art fails to teach or suggest the desorption of a definite amount of said control nucleic acid and/or the desorption of a definite amount of said control nucleic acid, whereby there is provided an essentially quantitatively reproducible and controlled amount of said control nucleic acid for submission to said comparable processing conditions.

The applicants further submit that in Van Beuningen, "*the term "internal reference" [i.e., the control] refers to any molecule stably associated with a substrate*" [emphasis added]; cf. page 9 lines 20-22 of Van Beuningen; and that Van Beuningen teaches that the internal reference only is an optional feature, which "*is eventually used*" [emphasis added]; cf. page 4 lines 33-36 of Van Beuningen.

Therefore, it is respectfully submitted that Van Beuningen (WO 2003/054551) neither discloses nor teaches all the features of claim 1 and that the Restriction Requirement and lack of unity determination are unsupported.

Withdrawal of the Restriction Requirement is respectfully requested along with examination of all of the claims.

An early and favorable Action on the merits of all of the claimed is requested.

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Respectfully submitted,

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